

Atty. Docket No.: 74324-297204

PATENT

REMARKS

The Applicant respectfully requests reconsideration of this application. No amendments or cancellations have been presented. Therefore, original claim 1 is presented for examination.

REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 103(A)

In the Office Action mailed February 22, 2005, the Examiner rejected claim 1 under 35 U.S.C. 103(a) as being allegedly unpatentable over Fink et al. (U.S. Patent No. 5,370, 692).

Claim 1 provides, *inter alia*, "performing virtual removal of a bone or portion thereof to be reconstructed with reference to the medical image data by simulating the surgical implantation procedure; creating a representation of a template contoured to fit the patient's anatomy to be repaired; and outputting a replica of the template by using Solid Freeform Fabrication manufacturing techniques." Fink et al. does not disclose at least these limitations of claim 1; therefore, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1 based on 35 U.S.C. § 103(a).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP* § 2143. In this case, Fink et al. does not disclose, teach, or suggest all the limitations of claim 1.

Fink et al. discloses "prosthetic bone implants are fabricated to approximately replicate a patient's original bone" (abstract), and "use of computer based imaging and manufacturing techniques to replicate the hard tissue being replaced by the prosthesis" (col. 1, lines 7-9). Thus Fink et al. teaches the direct fabrication of a hard tissue replication prosthetic, whereas embodiments of the present invention involve making "a template for use in pre-contouring bone reconstruction plates." Therefore, Fink et al. does not disclose, teach, or suggest at least

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"performing virtual removal of a bone or portion thereof to be reconstructed with reference to the medical image data by simulating the surgical implantation procedure; creating a representation of a template contoured to fit the patient's anatomy to be repaired; and outputting a replica of the template by using Solid Freeform Fabrication manufacturing techniques."

Applicant also respectfully disagrees with the Examiner's reliance upon an assertion concerning what is allegedly "old and notoriously well-known in the manufacturing art." It appears that the Examiner has taken official notice of the statement, "It is old and notoriously well known in the manufacturing art to virtual [sic] remove the main body part for precisely designing the support part, which supports the main body (like in auto, housing and space industries)" as it relates to "performing virtual removal of a bone." However, taking official notice of such a statement does not appear to adequately explain how the claim element "performing virtual removal of a bone or portion thereof to be reconstructed with reference to the medical image data by simulating the surgical implantation procedure" is made obvious, nor does such a statement provide the claim elements that Fink et al. lacks. "If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *MPEP* § 2144.03(B). Applicant respectfully requests the Examiner to "set forth explicitly" the basis for such official notice, and to provide supporting "specific factual findings" as they relate to the actual language of claim 1, rather than to the Examiner's paraphrase of an element of claim 1. Therefore, Applicant respectfully asserts that the Examiner's reliance upon such a statement of what is "old and notoriously well known in the manufacturing art" is improper, and respectfully requests the Examiner to withdraw the rejection of claim 1 based on 35 U.S.C. § 103(a).

For at least the aforementioned reasons, claim 1 is believed to be in condition for allowance, such being respectfully requested herein.

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CONCLUSION

The Applicant respectfully submits that the rejections have been overcome by the remark, and that the pending claim is in condition for allowance. Accordingly, the Applicant respectfully requests that the rejections be withdrawn and that a Notice of Allowance be issued for claim 1.

INVITATION FOR A TELEPHONE INTERVIEW

The Examiner is requested to call the undersigned at (303) 607-3709 if there remains any issue with allowance of the case.

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No fee is believed to be necessary for entry of this paper. In the event that any such fee is necessary for the entry of this paper, please charge to our Deposit Account No. 06-0029 any fees under 37 C.F.R. 1.16 and 1.17 which may be requested to enter this paper.

Respectfully submitted,

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